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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5000-1-110

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on NOVEMBER 16, 2007

Signature [Signature]

Typed or printed name Steve Cha

Application Number

09/621,384

Filed

July 21, 2000

First Named Inventor

Youn-Man Lee

Art Unit

2617

Examiner

Naghmeh Mehrpour

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

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Registration number 44069

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

[Signature]

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NOVEMBER 16, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Inventor: Youn-Man Lee
Serial No.: 09/621,384
Filed: July 21, 2000

Examiner: N. Mehrpour
Group Art Unit: 2617

Title: **METHOD FOR SAVING BATTERY BY CONTROLLING
DISPLAY IN PORTABLE TELEPHONE**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed August 16, 2007, Applicant has concurrently filed herewith a Notice of Appeal and fee and respectfully provides this Pre-Appeal Brief Request for Review regarding the above-identified application for the reasons indicated herein below:

REMARKS

(1) Claims 19-36 stand finally rejected under 35 U.S.C. 102(e) as allegedly being anticipated by over U.S. Patent 6,473,628 B1 to Kuno *et al.* ("Kuno").

Applicant respectfully submits that the Final Office Action of August 16, 2007, as well as the previous Office Action is plainly deficient in that it has clearly failed to meet the initial burden of showing a proper anticipation rejection under 35 U.S.C. §102(e), and has mischaracterized the applied reference (Kuno) in that virtually every col. and line number cited in the Office Action regarding Kuno clearly and unequivocally *does not in any way disclose what is alleged in the Office Action*. In previous requests for reconsideration, which will be addressed in detail below, the Applicant has explained reasons and provided arguments explaining why the USPTO did not meet this initial burden.

The Examiner's Response on Page 5 of the Final Office Action of August 16, 2007 was that the Applicant did not comply with 37 C.F.R. 1.111(c) because we did not clearly point out the patentable novelty in view of the art disclosed by the references.

Applicant is astounded by such a response, as our Request for Reconsideration filed August 3, 2007 addressed the inapplicability of each and every item that the Examiner alleged was purportedly disclosed by Kuno.

Applicant respectfully points out that while the Examiner has "parroted" Applicant's claim language in erroneously alleging an anticipation rejection, careful review shows that one cite after another of Kuno in the Final Rejection does not disclose what the Examiner alleges, as numerous-cited passages of Kuno clearly do not even come close to referring to what is alleged in the Final Office Action. Applicant traverses all the rejections of claims 19-36 and distinctly points

out the errors in the Examiner's rejection as follows:

Claim 19 of the present invention recites:

A battery saving method for controlling a display of a portable telephone, comprising: providing said display with a liquid crystal display (LCD); and after power on the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.

(1) While it is alleged in the Final Office Action that Kuno discloses the elements recited in present claim 19 at col. 4, lines 23-28 and col. 4, lines 45-63, Applicant respectfully notes that these two passages do not disclose the elements of the claim. The cited passages are completely irrelevant to the claim language recited in claim 19, as this portion of Kuno refers to the operation of a voice codec of a telephone. Thus, under 37 CFR 1.111(c), Applicant respectfully and clearly points out that the passages cited in Kuno fail to disclose *providing said display with a liquid crystal display (LCD) and after powering on the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.* The aforementioned elements are clearly not disclosed in the cited passage of Kuno, and are novel (and non-obvious at the time of invention to a person of ordinary skill in the art).

(2) In addition, with regard to independent claims 19 and 28, the Office Action has also cited portions of Kuno that clearly do not disclose what is alleged. For example, at page 2, 3rd paragraph of the Office Action, Kuno is alleged to disclose at col. 4, lines 32-38, a display comprising an LCD display.

Applicant notes that the aforementioned passage of Kuno actually discloses an analog voice signal, which may be received and transmitted, and is amplified by respective amplifiers. The term "LCD" or even a visual display is not used in this portion of Kuno. Thus, the Office Action fails to set forth proper reasons why the Kuno anticipates the claims for this reason alone.

(3) Additionally, at page 2, 3rd paragraph of the Office Action, Kuno is alleged to disclose at col. 2, lines 45-63 that after a power-on of the telephone, the LCD is maintained on until a call is established a predetermined time period has elapsed.

Applicant notes that the aforementioned passage Kuno actually discloses that a memory unit stores a plurality of images which are automatically displayed after a certain time period has elapsed to put the telephone in a standby mode, and the LCD stays on at all times. All Kuno discloses at this section is that images from memory are displayed once the telephone is in standby state. Therefore, Kuno fails to disclose the recitations in claims 19 and 28 of *providing said display with a liquid crystal display (LCD) and after power on the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired since establishment.*

Accordingly, in view of the above, the Examiner has failed to assert an initial anticipation rejection, as claims 19 and 28 are novel (and non-obvious) in view of Kuno. Thus, in view of the actual disclosure of Kuno, rather than allegations in the Final Office Action, Kuno fails to disclose or suggest all of the elements recited in claims 19 and 28 and a proper rejection under 35 U.S.C. §102 has not been set forth. In other words, the reference fails to disclose or suggest *providing said display with a liquid crystal display (LCD) and after power on the telephone, maintaining the LCD on until a call is established and a predetermined time period has expired*

since establishment. Applicant discloses in the specification the advantages of the present invention.

Thus, for at least the reasons specified above, claims 19 and 28 are patentable over the reference and the Examiner has failed to provide a proper *prima facie* rejection. All claims dependent from one of claims 19 or 28 are also patentable at least for the reasons indicated herein below and because of a separate basis of patentability.

Applicant further addresses a number rejections set forth in the Office Action herein below, and notes how the Office Action fails to present a proper *prima facie* rejection, **addressing each area of Kuno herein below that was improperly cited in the Office Action:**

(4a) With regards to claims 20 and 29, at page 2, last two lines in the Office Action, Kuno is alleged to display at col. 6, lines 10-19 that a backlight is provided.

Applicant notes that the aforementioned passage of Kuno says nothing about a backlight, and actually discloses the user setting a volume control in accordance with a flowchart shown in FIG. 3. The user sets the volume level by viewing a display and pressing a key, but that is all that is disclosed at this passage. Thus, claims 20 and 29 are patentable for independent reasons as the cited reference fails to disclose the recitations of *providing a backlight unit, and if there has been no call since power-on, maintaining the backlight off as long as no call is placed or received.* These features are novel (and non-obvious) and not disclosed by the cited passage of Kuno. The rejection is clearly improper and the initial burden to assert a *prima facie* rejection has not been set forth by the Examiner.

(4b) Moreover, with regard to claims 20 and 29, we note that at page 3, first two lines of the Office Action, Kuno is alleged to disclose at col. 2, lines 45-65 that the back-light power remains off as long as no call is placed or received.

Applicant notes that the aforementioned passage of Kuno actually discloses that a memory unit stores a plurality of images which are automatically displayed after a certain time period has elapsed to put the telephone in a standby mode, and the LCD stays on at all times. All Kuno discloses at this section is that images from memory are displayed once the telephone is in standby state. This passage is completely silent about a backlight being powered on or off.

(4c) With regard to claims 20 and 29, the Office Action alleges at page 3, first full paragraph and second paragraph of the Office Action, that Kuno discloses at col. 2, lines 45-64 that the back light remains off until one of two events occurs, the events being pressing the send key and receiving a ring signal for call termination.

Applicant notes that col. 2, lines 45-64 was also cited several times in the Office Action for disclosing different recitations and in every instance fails to disclose what is alleged in the Office Action. **Applicant notes that the aforementioned passage of Kuno (col. 2, lines 45-64) actually discloses that a memory unit stores a plurality of images which are automatically displayed after a certain time period has elapsed to put the telephone in a standby mode, and the LCD stays on at all times. All Kuno discloses at this section is that images from memory are displayed once the telephone is in standby state.** Thus claims 20 and 29 are not disclosed or suggested by Kuno and the citation to Kuno is improper. The Examiner has failed to carry the initial burden required to assert a *prima facie* rejection.

(5) With regard to claims 22 and 32, the Office Action alleges at page 3, 3rd paragraph that Kuno allegedly discloses at col. 9, lines 1-16 the turning on the LCD when the established call has ended.

Applicant notes that the aforementioned passage of Kuno *actually* discloses that the images from memory are switched on the display in a pseudo-random sequence, including exemplary images of fishes swimming, flying airplanes, and the head of a mole which are displayed in random sequence. Kuno says the different display of images starts after five minutes of not receiving a call or pressing any buttons, and is completely silent about turning on an LCD, particularly since the LCD displays the date and time for the first five minutes. Thus all of the elements recited in claims 22 and 32 are not disclosed or suggested by Kuno.

(6) With regard to claim 24, the Office Action alleges at page 3 fourth paragraph, that Kuno allegedly discloses at col. 10, lines 18-41 that if there has been a call since power-on, the back up light is off as long as no call is placed or received, subsequent to the most recent call.

Applicant notes that the aforementioned passage of Kuno *actually* discloses that when power to the telephone is turned on, or a call established with the telephone is terminated, the telephone enters a standby mode displaying telephone communication information on the display panel 16, the icon is turned off and the control unit selects images stored in ROM. Kuno says nothing about the backlight at this section.

(7) With regard to claim 27, at page 4, second full paragraph of the Office Action, Kuno allegedly discloses at col. 10, lines 48-59 that the telephone inherently teaches a computer program product comprising an embeddable program for performing the method of claim 19.

Applicant notes that the aforementioned passage of Kuno *actually* discloses hardware components including a microprocessor, RAM, etc. Disclosing such hardware components does not inherently disclose a computer program performing certain executable steps. According, claim 27 is novel (and nonobvious) in view of Kuno as the reference fails to disclose virtually any of the claimed elements, and thus does not inherently teach a computer program because it discloses a microprocessor, control unit, ROM, RAM, and display panel in this cited passage.

(8) With regard to claim 31 and 36, the Office Action alleges at page 4, third full paragraph, that Kuno allegedly discloses at col. 2, lines 45-65 that the LCD is maintained until a call is established and a predetermined time period has expired.

Applicant again notes that this particular passage of Kuno, which is cited in some of the aforementioned numbered items, does not disclose what is alleged in the Office Action.

Applicant notes that the aforementioned passage Col. 2, lines 45-64 of Kuno *actually* discloses that a memory unit stores a plurality of images which are automatically displayed after a certain time period has elapsed to put the telephone in a standby mode, and the LCD stays on at all times. All Kuno discloses at this section is that images from memory are displayed once the telephone is in standby state. Accordingly, claims 31 and 36 are patentable in view of Kuno as the passage cited fails to disclose or suggest the recited elements.

(9) With regard to claim 35, the Office Action discloses at page 4, last paragraph, that Kuno allegedly "inherently" teaches at col. 9, lines 14-25, that the telephone has a backlight for the LCD, and the process is configured to maintain the backlight on if there has been a call since power on,

and the back light maintained off as long as no call is placed.

Applicant notes that the aforementioned passage at col. 9, lines 14-25 of Kuno actually discloses that after five minutes of not receiving a call or pressing a button, the image on the display changes from communication information to images retrieved from memory and displayed randomly. Kuno says nothing about a back light at this section. Applicant does note that Kuno appears to disclose at col. 9, lines 53-60, that the images are displayed intermittently while in a battery saving mode. Displaying images intermittently while in a battery saving mode does not disclose or suggest powering on or off an LCD and/or a backlight as claimed in the present claimed invention. Thus, claim 35 is also patentable in view of the references and the rejection thereof is erroneous.

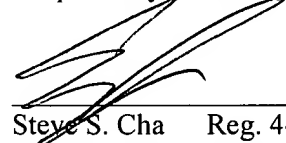
Applicant respectfully submits that the USPTO has failed to set forth a *prima facie* rejection under 35 U.S.C. §102(e).

Applicant further notes that a careful reading of Kuno shows that the reference fails to disclose or suggest the present claims. Kuno discloses a device primarily concerned with displaying different images on telephone displays for users who are looking to be amused by their telephone. The normal display changes to pseudo-random sequences of stored images to surprise the user, who does not know which image is going to be displayed in any sequence. However, the structure, operation and advantages of the present claims are not obviated by Kuno's disclosure of the pseudo-random display of different images while a telephone is in a standby mode, which does not save power, nor does it extend the life of the LCD and/or backlight.

Applicant respectfully submits that the rejections of the present claims not only have an improper foundation, but said rejections are believed to be an arbitrary and capricious action by the Examiner that is contrary to 35 U.S.C. §102, the rules as specified under 37 C.F.R. and the Manual of Patent Examining Procedure. Applicant further respectfully submits that the actions of the USPTO have damaged and prejudiced the rights of the Applicant as the aforementioned actions, which are believed to be arbitrary and capricious actions of the Examiner, were in response to an Appeal Brief previously filed January 8, 2007. Applicant respectfully submits that MPEP 706.02(l) instructs the Examiner to use the best prior art available, which for at least the above reasons, if Kuno is the best art available, clearly renders the present claims patentable as the Examiner has not been able to set forth a single proper *prima facie* rejection of the claims.

Date: November 16, 2007
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Respectfully submitted,



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